

REMARKS

By this Amendment, Applicants have amended claims 1, 9-12 and 16-18 by incorporating the subject matter recited in now-cancelled claim 4. In addition, Applicants have cancelled claim 4, without prejudice or disclaimer. Moreover, Applicants have amended claims 11 and 18 to recited a computer-readable medium loadable into a memory of a computer. Upon entry of this Amendment, claims 1-3 and 5-18 are pending and under current examination.

In the Office Action¹, the Examiner took the following actions:

- (1) objected to the title;
- (2) requested to file a certified copy of the JAPAN 2004-258638 application as required by 35 U.S.C. § 119(b);
- (3) rejected claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (4) rejected claims 11 and 18 under 35 U.S.C. § 101, as being directed to non-statutory subject matter;
- (5) rejected claims 1-3, 5-7, and 9-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0126994 ("Gunji");
- (6) rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of U.S. Patent No. 6,53,180 ("Kikuchi"); and

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

(7) rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of U.S. Patent No. 6,298,173 ("*Lopresti*").

Based on the foregoing amendments and the following remarks, Applicants traverse the objection to the title and rejections of the pending claims.

Information Disclosure Statement

Applicants note that the Examiner did not return the PTO/SB/08 form associated with the Information Disclosure Statement (IDS) filed on May 5, 2006 (the Examiner only returned the second page of the IDS). Applicants respectfully request that the Examiner return the PTO/SB/08 form with appropriate notations indicating the references have been considered in the next communication.

In addition, Applicants note that the Examiner lined through the references cited in the IDSs filed on May 26, 2007 and December 12, 2008, but did not indicate the reasons. Applicants respectfully request that the Examiner consider the references cited in these IDSs and, provide reasons if not so doing.

Objection to the Title

In the Office Action, the Examiner objected to the title as not being descriptive. See Office Action, page 2. Although Applicants do not agree with the objection, Applicants have amended the title, in an attempt to expedite prosecution. Accordingly, Applicants respectfully request that the Examiner withdraw the objection to the title.

Priority

Applicants thanks the Examiner for acknowledging the priority of this application. Applicants will file a certified copy of JAPAN 2004-258638 application in a Supplemental Communication in the near future.

Rejection of Claim 4 under 35 U.S.C. § 112, Second Paragraph

First, the rejection of claim 4 is moot due to its cancellation. Second, in response to the Examiner assertions that “it is not clear whether [the term ‘the image’ recited in claim 4, lines 7 and 8] is in reference to ‘the moving image’ or ‘the encoded image’” (Office Action, page 2), Applicants have amended the corresponding portions of claim elements in amended claims 1, 9-12 and 16-18, to more clearly define the claimed invention. Support for this amendment may be found in the specification at, for example, pars. [0124] and [0125]. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph, rejection.

Rejection of Claims 11 and 18 under 35 U.S.C. § 101

The Office Action asserted that claims 11 and 18 are directed to non-statutory subject matter. See Office Action, pages 2-3. In response, and without conceding to the Office Action’s assertions, Applicants have amended claims 11 and 18 to recite a computer readable medium loadable into a memory of a computer. Applicants submit that these amendments address the 35 U.S.C. § 101 rejection of claims 11 and 18. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection.

Rejection of Claims 1-3, 5-7, and 9-18 under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-3, 5-7, and 9-18 under 35 U.S.C. § 102(b) as being anticipated by *Gunji*, because *Gunji* fails to disclose each and every element of claims 1-3, 5-7, and 9-18.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

In the Office Action, the Examiner acknowledged that *Gunji* fails to disclose Applicants' claimed "wherein the recording control means: controls recording of the moving image onto the data recording medium such that the moving image in a predetermined time for playback is recorded in a first contiguous area of the data recording medium; and controls recording of the encoded image onto the data recording medium such that the encoded image is recorded in a second contiguous area of the data recording medium when the amount of data of the encoded image exceeds a predetermined threshold if the recording of the moving image in the first area of the data recording medium is ended," as recited in amended claim 1. See Office Action, page 7.

Since *Gunji* fails to disclose each and every element of claim 1, *Gunji* does not anticipate claim 1. Claim 1 is therefore allowable over *Gunji*. Claims 9-12 and 16-18, while of different scope, contain recitations similar to claim 1, and are also allowable over *Gunji*. Dependent claims 2-3, 5-7, and 13-15 depend from independent claim 1 or 12, and are allowable at least by virtue of their respective dependence from allowable independent claim 1 or 12. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection.

Rejection of Claim 4 under 35 U.S.C. § 103(a)

The rejection of claim 4 is moot by virtue of its cancellation. Therefore, the following discussion is in relation to claims 1, 9-12, and 16-18, which contain subject matter recited in now-cancelled claim 4. The Office Action alleged that *Gunji* in view of *Kikuchi* renders the subject matter recited in now-cancelled claim 4, which has been incorporated into amended claims 1, 9-12, and 16-18, obvious. See Office Action, page 7. Applicants respectfully disagree.

The Office Action has not properly resolved the *Graham* factual inquiries, as required to establish a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007). In particular, the Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because the Office Action has not properly interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

The Office Action acknowledged that *Gunji* fails to disclose Applicants' claimed "wherein the recording control means: controls recording of the moving image onto the data recording medium such that the moving image in a predetermined time for playback is recorded in a first contiguous area of the data recording medium; and controls recording of the encoded image onto the data recording medium such that the encoded image is recorded in a second contiguous area of the data recording medium when the amount of data of the encoded image exceeds a predetermined threshold if the recording of the moving image in the first area of the data recording medium is ended," as recited in amended claim 1. See Office Action, page 7.

However, the Office Action alleged that *Kikuchi* teaches the above-quoted claim elements. See *Id.* Specifically, the Office Action alleged that *Kikuchi* teaches these claim elements in Fig. 36, where “the thumbnail management area is stored together, with each of the thumbnail picture stored together (table).” *Id.* Applicants respectfully disagree.

Kikuchi does not cure the deficiencies of *Gunji*. For example, Fig. 36 of *Kikuchi* merely shows a file structure of a menu containing thumbnails. See *Kikuchi*, col. 5, lines 18-20. See also *Kikuchi*, col. 27, lines 60-62. However, *Kikuchi* does not disclose or suggest the same process of recording such thumbnails as recited in amended claim 1. *Kikuchi* discloses a different recording method. For example, *Kikuchi* discloses that “[t]his user menu file stores, as first data, pointer addresses called anchor points ... [a]fter the anchor points, the thumbnail picture management section is recorded... [a]fter those data, the start address and data length of a defective area are recorded... [a]fter these data, the backup of the thumbnail picture management section is recorded... [a]fter the backup, a group of actual packed thumbnail picture data are recorded....” *Kikuchi*, col. 28, lines 1-30 (emphasis added). Therefore, it is clear that *Kikuchi*’s thumbnail data are recorded after a series of other non-moving image data have been recorded. In contrast, Applicants’ amended claim 1 recites “controls recording of the encoded image onto the data recording medium ... if the recording of the moving image in the first area of the data recording medium is ended” (emphasis added).

Furthermore, when recording the thumbnail data, *Kikuchi*’s method does not determine whether the amount of data of the thumbnail “exceeds a predetermined threshold,” as recited in Applicants’ amended claim 1.

Thus, the Office Action has not properly ascertained the differences between the prior art and the claimed invention. In view of the reasoning presented above, Applicants therefore submit that independent claim 1 is not obvious over *Gunji* and *Kikuchi*, whether taken alone or in combination. Independent claim 1 should therefore be allowable. Claims 9-12 and 16-18, while of different scope, contain recitations similar to claim 1, and are also allowable over *Gunji* and *Kikuchi*.

Rejection of Claim 8 under 35 U.S.C. § 103(a)

Applicants request reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of *Lopresti*.

As discussed above, *Gunji* fails to disclose Applicants' claimed "wherein the recording control means: controls recording of the moving image onto the data recording medium such that the moving image in a predetermined time for playback is recorded in a first contiguous area of the data recording medium; and controls recording of the encoded image onto the data recording medium such that the encoded image is recorded in a second contiguous area of the data recording medium when the amount of data of the encoded image exceeds a predetermined threshold if the recording of the moving image in the first area of the data recording medium is ended," as recited in amended claim 1.

Lopresti does not cure the deficiencies of *Gunji*. For example, *Lopresti* discloses "a method of managing storage in a document image database using document analysis to partition documents into logical regions." *Lopresti*, Abstract. However, *Lopresti* does not discloses or suggest Applicants' claimed "wherein the recording control means: controls recording of the moving image onto the data recording medium

such that the moving image in a predetermined time for playback is recorded in a first contiguous area of the data recording medium; and controls recording of the encoded image onto the data recording medium such that the encoded image is recorded in a second contiguous area of the data recording medium when the amount of data of the encoded image exceeds a predetermined threshold if the recording of the moving image in the first area of the data recording medium is ended," as recited in amended claim 1.

Thus, the Office Action has not properly ascertained the differences between the prior art and the claimed invention. In view of the reasoning presented above, Applicants therefore submit that independent claim 1 is also not obvious over *Gunji* and *Lopresti*, whether taken alone or in combination. Independent claim 1 should therefore be allowable. Therefore, dependent claim 8 is allowable at least by virtue of its dependence from allowable independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 8.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 13, 2009

By: /David W. Hill/
David W. Hill
Reg. No. 28,220